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TO Supervisory Primary Examiner Henry Bennett (Group 3743) **FAX NO.** 703-872-9303

FIRM/COMPANY U.S. Patent and Trademark Office **VOICE NO.** 703-308-0101

FROM T. Murray Smith **VOICE NO.** 214.953.6684 **DATE** October 23, 2002

RETURN TO Judy Baggett **FAX NO.** 214.953.6503 **PAGES (including cover)** 8

MESSAGE

Applicant: Weber, et al.
Serial No.: 08/675,280
Filed: July 1, 1996
Title: CONSTRUCTION OF PHASE CHANGE MATERIAL EMBEDDED
ELECTRONIC CIRCUIT BOARDS AND ELECTRONIC CIRCUIT BOARD
ASSEMBLIES USING POROUS AND FIBROUS MEDIA

Attorney Docket No. 004578.0778

Group: 3743
Examiner: Christopher Atkinson

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GROUP 3700

Please immediately notify Examiner Henry Bennett by e-mail (or by telephone at 703-308-0101) that this cover sheet (with the enclosed Petition) has been received. Thank you.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this cover sheet and the enclosed Petition are being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

Signature: T. Murray Smith
T. Murray Smith, Reg. No. 30,222

Date: 10-23-2002

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1

PATENT APPLICATION
08/675,280

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: WEBER, et al.
Serial No.: 08/675,280
Filing Date: July 1, 1996
Group Art Unit: 3743
Examiner: Christopher Atkinson
Title: CONSTRUCTION OF PHASE CHANGE
MATERIAL EMBEDDED ELECTRONIC
CIRCUIT BOARDS AND ELECTRONIC
CIRCUIT BOARD ASSEMBLIES USING
POROUS AND FIBROUS MEDIA
Attorney Reference: 004578.0778

Attention: SPE Henry Bennett

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

PETITION UNDER 37 CFR §§1.181 and 1.193

This Petition is accompanied by a facsimile cover sheet, which serves as a transmittal, and which contains an executed certificate of facsimile transmission.

Pursuant to the provisions of 37 CFR §§1.181(a) and 1.193(a)(2), Applicants are submitting this Petition to raise an objection to the Examiner's Answer mailed on October 2, 2002. In particular, Applicants object to a new ground of rejection which is contained in the arguments of the Examiner's Answer. For reasons discussed in more detail below, it is believed that no fee is required for this Petition. This Petition is being submitted less than a month

ATTORNEY DOCKET NO.
004578.0778

2

PATENT APPLICATION
08/675,280

after mailing of the Examiner's Answer, and is thus timely under the two-month period provided by 37 CFR §1.181(f).

Turning in more detail to the Examiner's Answer, the paragraph bridging pages 6-7 contains an argument by the Examiner in support of a rejection of Claims 25-27 and 30-31 for anticipation under 35 USC §102. In this regard, independent Claims 25 and 30 each include a limitation specifying that a porous material within a cavity of an enclosure is "coupled physically" to a highly thermally conductive portion of the enclosure. Within the indicated paragraph of the Examiner's Answer, a sentence at lines 7-8 on page 7 makes the following assertion regarding the present application:

Also, there is no written disclosure that teaches one how to physically couple the matrix to a container.

As a courtesy, Applicants are attaching to this Petition a copy of pages 6-7 from the Examiner's Answer, on which this particular sentence is highlighted. In essence, the indicated sentence asserts: (1) that the disclosure of the present application fails to support the recitation in independent Claims 25 and 30 of one part being "coupled physically" to another part, and (2) that the present application fails to provide an "enabling" disclosure that teaches how these two parts can be "coupled physically". Consequently, this sentence is effectively imposing on independent Claims 25 and 30 a new ground of rejection under the first paragraph of 35 USC §112.

The final rejection mailed on June 3, 2002 does not set forth any rejection of independent Claims 25 and 30 under §112. The final rejection thus reflects a conclusion by the Examiner that the specification of the present application

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ATTORNEY DOCKET NO.
004578.0778

3

PATENT APPLICATION
08/675,280

does support and provide an enabling disclosure of all subject matter recited in these two claims. To the extent that the indicated sentence in the Examiner's Answer now takes a contrary position, the sentence is imposing a new ground of rejection as to Claims 25 and 30.

The provisions of 37 CFR §1.93(a)(2) specify that an "examiner's answer must not include a new ground of rejection" (subject to an exception that does not apply here). This is confirmed in the first paragraph of MPEP §1208.01, which goes on to state that "where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal". MPEP §1002.02(d)(2) confirms that "Approval of any new ground of rejection made after the filing of an appeal brief" is to be made by a supervisory patent examiner.

Since 37 CFR §1.193(a)(2) expressly prohibits the entry of a new ground of rejection in an examiner's answer, the introduction of a new ground typically does not involve an express statement by an examiner that a new ground of rejection is being imposed. Instead, in the typical situation, the examiner's arguments inadvertently have the effect of imposing a new ground of rejection, even though the examiner did not specifically intend to impose a new ground of rejection, and thus did not identify it as such. That is precisely what has occurred in the present application.

Where an applicant recognizes that this has occurred, MPEP §1208.01 provides that:

Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR §1.181(a).

ATTORNEY DOCKET NO.
004578.0778

4

PATENT APPLICATION
08/675,280

Consequently, Applicants are submitting the present Petition under the provisions of 37 CFR §§1.181(a) and 1.193(a)(2), in order to raise a timely objection to the fact that the Examiner's Answer mailed on October 2, 2002 improperly imposes a new ground of rejection under the first paragraph of 35 USC §112 as to Claims 25-27 and 30-31. Applicants respectfully request that the Examiner withdraw the existing Examiner's Answer, and then either (1) issue a new Examiner's Answer which does not include language imposing a new ground of rejection, or (2) obtain approval from a supervisory patent examiner under MPEP §1002.02(d) to reopen prosecution for the purpose of properly imposing any new ground of rejection that the Examiner wishes to maintain.

As mentioned above, it is believed that no fee is required for this Petition. In this regard, the provisions of MPEP §1208.01 which are quoted above make it clear that the proper course of action in the present situation is to file a petition under 37 CFR §§1.181(a) and 1.193(a)(2). The provisions of 37 CFR §1.181(d) specify that, if a fee is required, "the appropriate section of this part will so indicate". In the present situation, the "appropriate section" is 37 CFR §193, which does not contain any reference to any petition fee. Accordingly, no fee is being submitted with this Petition.

MPEP §1002.02(d)(2) provides that the issue presented by the present Petition is to be decided by a "supervisory patent examiner". With reference to the signature area at the bottom of page 8 of the Examiner's Answer, it would appear that the appropriate supervisory patent examiner for purposes of the present application is Supervisory Examiner Henry Bennett, and this Petition is therefore being directed to the attention of Examiner Bennett.

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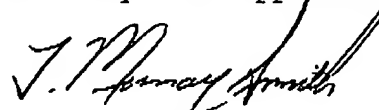
ATTORNEY DOCKET NO.
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5

PATENT APPLICATION
08/675,280

In view of the foregoing, it is respectfully requested that this Petition be granted. In particular, it is respectfully requested that the Examiner withdraw the existing Examiner's Answer, and then either (1) issue a new Examiner's Answer which does not include language imposing a new ground of rejection, or (2) obtain approval from a supervisory patent examiner under MPEP §1002.02(d) to reopen prosecution for the purpose of properly imposing any new ground of rejection that the Examiner wishes to maintain.

Respectfully submitted,
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Date: October 23, 2002

Enclosure: Copy of pages 6-7 of Examiner's Answer,
with a sentence highlighted

Application/Control Number: 09/280,775

Page 6

Art Unit: 3743

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in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. First, the examined claims do not read on the embodiment of Figure 1 since this non-elected species is abandoned per the Board of Appeals Decision. Only the non-elected embodiment (i.e. Figure 1) on page 7 of applicants originally filed specification does it state that the PCM 7 partially or fully fills the remainder of the cavity. Nowhere in the originally filed specification does it state that the elected embodiments' (i.e. Figure 2) cavity can be fully filled with the PCM 27. However, Figure 3 of applicant's application does show a gap between the phase change medium (27) and the plate (21). Therefore, contrary to the device of claims 26 and 31, the phase change medium (27) as illustrated in Figure 3 can slide or move within the cavity (i.e. enclosed internal space). Also, when the phase change medium changes from a solid phase to a liquid phase, the phase change medium again can and will flow or move within the cavity since nowhere in the originally filed specification does it state that the elected embodiments' (i.e. Figure 2) cavity can be fully filled with the PCM 27.

Appellant's concerns directed toward Telkes are not found persuasive. Telkes, in Figure 4 and in column 4, lines 9-10 and 43-51, is believed to anticipate applicant's claimed invention since Telkes states, in column 4, line 10, glass is a material which has a suitable heat-conductivity and it therefore is read as a heat transfer material. Also, the matrix 14' is coupled physically (see figure 4) to the wall in view of Telkes stating the matrix "will not settle to the bottom". Matrix (14') is physically coupled (i.e. in contact with the container, see figure 4) and thermally (since the

Application/Control Number: 09/280,775

Page 7

Art Unit: 3743

COPY

matrix 14' is touching the container and glass is a thermal conductor as stated by Telkes in column 4, line 10 and as shown in figure 4) coupled to the container (10). Also, see column 2, lines 15-33 and column 4, lines 43-51 in Telkes. Appellant's arguments to the physical coupling of the matrix to the container are not commensurate in scope with the claims. Claims 25-27 and 30-31 do not recite or require any additional structure or material which physically couples the matrix to the container. Therefore, if the matrix touches the container wall it meets the limitation of physically coupled within the claims. Also, there is no written disclosure that teaches one how to physically couple the matrix to a container. Therefore, the Examiner believes touching meets the limitation of physical coupling. Therefore, since Telkes discloses the matrix (14') touching the wall (see figure 4 in Telkes) of the container, the matrix 14' in Telkes meets the limitation of physically coupled to the container within the claims.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5